

Customer No.: 31561  
Application No.: 10/709,720  
Docket No.: 11249-US-PA

REMARKS

Present Status of the Application

Claims 1-5 remain pending. The Office Action has rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Deluca et al. (US-5,784,001, hereinafter Deluca) in view of Miyashita (US-005574439A, hereinafter "Miyashita").

For at least the following traversals, Applicant respectfully submits that claims 1-5 are in proper condition for allowance. Reconsideration is respectfully requested.

Discussion of the claim rejection under 35 USC 103

*The Office Action has rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Deluca et al. (US-5,784,001, hereinafter Deluca) in view of Miyashita (US-005574439A, hereinafter "Miyashita").*

Deluca teaches the following in col. 1, lines 30 – 40:

"Data communication receivers that receive alphanumeric messages and the systems in which they are registered therefore usually are language-specific. As a result, a user who speaks a particular language is unable to understand received messages if he roams into a system in which messages are transmitted in a different language."

Thus, what is needed is a method and apparatus for providing selective call messages that are not language-specific."

According to MPEP 2143.01, "[t]he combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.)".

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Furthermore, MPEP 2144.05 includes the following: “[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)”

In Deluca, the use of graphic messages on the display 130 is emphasized to be critically important for the essence of the invention taught in Deluca, because only graphic messages allow for “**providing selective call messages that are not language-specific**”, which is **not possible** when using a **TEXT-based** system as is the case in the present invention.

The method taught in Deluca as described in col. 2, lines 42-67 is as follows: the data communication receiver 100 is able to receive both conventional alphanumeric messages and graphics messages, which are indicated by predetermined codes included in received messages. Predetermined characters can be used to designate selected codes representative of predetermined graphic images. When at least one predetermined code is recognized by the data communication receiver 100, a graphics message comprising one or more graphic images is presented to the user of the receiver 100. The graphic message conveys, in pictures, a universally understood meaning to the user of the data communication receiver 100. In other words, to satisfy the requirement of not being language-specific, the codes are required to be converted to be image data, and is different from the converting of symbol into inserting content (text message) as taught in the present invention.

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As a result, it is clearly evident that Deluca **clearly teaches away** from the claimed invention, and therefore cannot be used in a rejection under obviousness per 35 U.S.C. 103(a). Without Deluca, Miyashita alone is clearly insufficient for forming a **prima facie** of case of obviousness.

Therefore, claims 1-5 should be allowed.

For at least the foregoing reasons, Applicants respectfully submit that claims 1-5 patently define over Deluca. Reconsideration and withdrawal of above rejections is respectfully requested.

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CONCLUSION

For at least the foregoing reasons, it is believed that all pending claims 1-5 are in proper condition for allowance. If the Examiner believes that a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned counsel to arrange for such a conference.

Date : June 2, 2006

Respectfully submitted,

  
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